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In re Application of
Herle et al.
Application No. 10/035,800
Filed: December 28, 2001
Attorney Docket No. SAMS01-00185

OFFICE OF PETITIONS
DECISION DISMISSING PETITION

This is a decision on the petition under 37 CFR 1.47(b), filed on April 9, 2002, requesting that an inventor be allowed to file the application on behalf of himself and his joint-inventor who allegedly refuses to join in this application. The petition is being properly treated as a petition under 37 CFR 1.47(a).

The petition is **DISMISSED**.

There are 2 joint-inventors named for the claimed invention in this application: Sudhindra P. Herle ("Herle") and Mark Mitchell ("Mitchell"). The declaration filed with the application on December 28, 2001 was not signed as required by 37 CFR 1.51(b)(2) and as specified in 37 CFR 1.63. On January 28, 2002, the Office of Initial Patent Examination (OIPE) mailed a Notice to File Missing Parts of Nonprovisional Application ("1/28/02 Notice"), giving Applicants an extendable, non-statutory 2-month period within which to submit, *inter alia*,¹ a proper oath/declaration. In response, the instant petition was filed, requesting that a "Declaration and Power of Attorney" signed by Herle but not Mitchell ("4/9/02 Declaration") be accepted, such that Herle may make this application on behalf of himself and Mitchell who allegedly refuses to join in this application.

Herle may file this application on behalf of himself as well as Mitchell, provided that a *bona fide* attempt has been made to present to Mitchell, for signature, a copy of the **entire application (specification including claims; drawings)**,² and that Mitchell **refuses to join in this application**. To show that Mitchell has refused to join in this application despite a *bona fide* attempt made to present to him for signature a copy of the entire application, the petition must include, *inter alia*, a **statement of facts concerning the circumstances of the presentation of the application papers to Mitchell at his last known address,**³ and his subsequent refusal.⁴

¹ The other missing item is the application basic filing fee.

² MPEP section 409.03(d) (Aug. 2001) REFUSAL TO JOIN.

³ 37 CFR 1.47(a); also see MPEP section 409.03(e) (Aug. 2001).

⁴ See MPEP section 409.03(d) (Aug. 2001) (Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . . When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.).

The instant petition is supported solely by a declaration of John T. Mockler, counsel for the assignee-of-record for this application ("Mockler") ("Mockler Declaration"), which is essentially a statement of facts setting forth that:

- "a draft of the subject patent application" was sent to Mitchell on November 26, 2001;⁵ and that
- "upon information and belief, . . . Mitchell has refused to sign the Declaration and Power of Attorney in the present application"⁶

However, the Mockler Declaration fails to specify whether the "draft patent application" allegedly sent to Mitchell with a November 26, 2001 letter contained the entire application including the specification, claims, and drawings. Consequently, the Office is unable to conclude that the Mockler Declaration constitutes the "statements of facts" required for granting a petition under 37 CFR 1.47(a).⁷ The instant petition is thus dismissed, and the 4/9/02 Declaration is not accepted.

Options

To prevent abandonment of this application, **either** of the following must be filed within **TWO MONTHS** from the mailing date of this decision:⁸

- OR,
- (1) An oath/declaration properly executed by **both** Herle and Mitchell;⁹
 - (2) A request for reconsideration of this decision (renewed petition under 37 CFR 1.47(a)) (no fee), that:
 - includes appropriate **statement(s) of facts**,¹⁰ stating that the **entire application papers, including the specification, claims, drawings, and oath/declaration, were presented to Mitchell at his last known address; and of the facts relied upon to conclude that Mitchell refuses to join in this**

⁵ Mockler Declaration, page 2, paragraph 6.

⁶ Mockler Declaration, page 2, paragraph 10.

⁷ See supra note 4.

⁸ Unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained. See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration by the applicant pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . and pay the surcharge required by §1.16(e) to avoid abandonment.).

⁹ Submit directly to OIPE, along with a copy of this Decision.

¹⁰ See supra note 4. If a renewed petition under 37 CFR 1.47(a) is still proper, the 4/9/02 Declaration enclosed with the instant petition does **not** need to be resubmitted.

application,¹¹ and

-is addressed as follows:
by mail/by hand:

Assistant Commissioner for Patents, USPTO
Attn: Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

by fax:

(703)308-6916
Attn: Office of Petitions

Finally, the Office acknowledges receipt with the instant petition of the \$130 petition fee, the \$740 basic filing fee for this application, and the \$130 surcharge for late filing of the declaration and the basic filing fee.

Telephone inquiries concerning this decision should be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹¹ To ensure grantability of the renewed petition under 37 CFR 1.47(a), counsel must, if not having already done so, provide Mitchell with a copy of the entire application papers and allow him reasonable time to review before deciding whether to sign.